



UNITED STATES DEPARTMENT OF COMMERCE
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077,346,772	07/27/88	MESSIER	L

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EXAMINER	
CONSTANTINOU	
ART UNIT	PAPER NUMBER
336	10

DATE MAILED:

04/18/89

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 1-25-89 ☐ This action is made final.
(three) 3

A shortened statutory period for response to this action is set to expire _____ month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 21-23 + 26 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 21-23 + 26 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections **MUST** be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☒ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☒ been filed in parent application, serial no. 07/058,766; filed on 6-5-88
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 233.
14. ☐ Other

Claims 21-23 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what is meant by the terminology "means for retaining . . . in a vagina" in that such language does not define what is being retained. For example claiming -- means for retaining the closed end of the thin walled tube within a vagina . . . -- would be clear.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 21-22 and 26 are rejected under 35 U.S.C. 103 as being unpatentable over Graham in view of Dyck et al.

Graham shows everything claimed except the thin walled tubing 3 and 4 is not made from a polymer material being selected from the group consisting of polyethylene, polyurethanes and derivatives thereof.

Specifically the tubular elements 3, 4 and 1 together define a thin walled tube. Applicant's claimed "first elastic ring" reads on element 8 of Graham because as seen from Figs. 1-3 it has a diameter slightly larger than the diameter of the tube 4, and it therefor radially stretches tube 4 (as claimed in claim 22) which is made from a flexible elastic material. Applicant's claimed "means for retaining" reads on either elements 1 or 3 of Graham because: (a) element 3 retains fluid within the tube and/or, (b) element 1 is essentially located at the closed end of the tube since Graham teaches that element 3 can be maintained within band 1 (see p. 2 lines 50-56).

Although the specific material used by Graham is rubber, Graham does not limit himself to only using rubber in that he teaches generally using an elastic flexible material (see p. 1 col. 39). Dyck et al. teach making sperm receiving tubular sheaths from applicant's claimed material because they allow the sheath to be made "thin enough so as not to impair movement or feeling . . . but strong enough to prevent the formation of pinholes" (see col. 1 lines 36-41). It would have been obvious to one of ordinary skill in the art to construct the sheath of Graham from materials such as polyurethane in view of Dyck et al. in order to make the sheath thin enough so as not to impair movement and sensation but strong enough to prevent rupture.

Claims 21-²²~~24~~ and 26 are rejected under 35 U.S.C. 103 as being unpatentable over Hollmann in view of Dyck et al. and optionally Graham.

Hollmann shows a feminine condom which shows everything claimed except it is not made from polyethylene or polyurethane. Specifically note sheath "b" which is made from rubber and first ring "a" which has a diameter greater than the diameter of "b". Applicant's claimed "means for retaining . . . in a vagina near the uterus of a user" reads on the closed end of the sheath of Hollmann because the closed end retains fluids.

It would have been obvious to one of ordinary skill in the art to make the sheath of Hollmann from polyurethane in view of Dyck et al. because polyurethane permits production of a sheath which is thin enough so as not to impair movement and sensation but strong enough to prevent rupture.

Optionally, it would have been obvious to one of ordinary skill in the art to include a ring at the closed end of the sheath of Hollmann for the purpose of retaining the sheath within the vagina of a user as taught by Graham.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 23 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 2 of prior United States Patent No. 4,735,621.

This is a double patenting rejection.

The patented claim claims the same structure, element by element, as does claim 23. Although claim 23 uses the transitional phrase "comprising" there are no

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additional elements in the specification which are encompassed by such language.

Claims 21-22 and 26 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over the prior invention as set forth in claims 1-3 of United States Patent No. 4,735,621. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed "means for retaining" reads on the claimed patented second ring.

The obviousness type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In *re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).


Applicant's arguments filed January 25, 1989 have been fully considered but they are not deemed to be persuasive.

Applicant's arguments with respect to claims 21-23 and 26 have been considered but are deemed to be moot in view of the new grounds of rejection.

Any inquiry concerning this communication should be directed to Mario Costantino at telephone number 703-557-3125.

MCostantino:myl

4/12/89 *ml*


C. FRED ROSENBAUM
S. P. E.
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